



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/030,825	02/26/98	SHENHOLZ	G 172/19

LM02/0922  
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EXAMINER

SHANKAR, V

ART UNIT

PAPER NUMBER

2778

DATE MAILED:

09/22/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 2/26/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 15-19 is/are pending in the application.
- Of the above claim(s) 1-14 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 15-19 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2, drawn to an ultrasound receiver assembly, classified in class 345, subclass 177.
  - II. Claims 3-6, drawn to an ultrasound-based digitizing system for identifying the position of an ultrasound transmitter and receiver , classified in class 178, subclass 18.04.
  - III. Claims 7-14, drawn to a transmitter device for use with a system for digitizing operative strokes of a hand-held drawing implement, classified in class 178, subclass 19.02.
  - IV. Claims 15-19, drawn to a narrow-band eraser device , classified in class 178, subclass 19.01.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-VIII are disclosed as different combinations which are not connected in design, operation or effect. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MEP. 806.04, MEP. 808.01). In the

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instant case the combinations are based on vastly different functions ranging from an ultrasound receiver assembly; an ultrasound-based digitizing system for identifying the position of an ultrasound transmitter and receiver and a presentation board digitizer system for digitizing operative strokes of a drawing implement; a transmitter device for use with a system for digitizing operative strokes of a hand-held drawing implement; and a narrow-band eraser device.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-IV, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I and III-IV, restriction for examination purposes as indicated is proper.
6. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I,II,IV, restriction for examination purposes as indicated is proper.

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7. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group I-III, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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11. During a telephone conversation with Michael Glenn on 9-17-99 a provisional election was made without traverse to prosecute the invention of group IV , claims 15-19.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

12. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

***Priority***

13. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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15. Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Holtzman (5,866,856).

Regarding Claim 15, Holtzman teaches an eraser device for use with a presentation board digitizer system, the eraser device comprising: a handle; an eraser element having a flat eraser surface (fig.6); and a pivot joint connecting between the handle and the eraser element, the pivot joint having two degrees of rotational freedom (fig.6; col.5, lines 65-67) such that, in use, the eraser element assumes an orientation with the eraser surface parallel to the presentation board surface independent of the orientation at which the handle is held (summary; fig.6; col.5, line 38- col.6, line 9).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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17. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mallicoat (4,777,329 as provided in PTO-1449) in Tang et al (5,325,110).

Regarding Claim 15, Mallicoat teaches an eraser device for use with a presentation board digitizer system, the eraser device comprising: a handle; an eraser element having a flat eraser surface (fig.7); and a plurality of contact microswitches located on the eraser surface, such that when a portion of the eraser surface contacts the presentation board, at least one microswitch corresponding to the portion is activated and when an entirety of the eraser surface contacts the presentation board all of the microswitches are activated (Figs.1-3,5,7; summary; col.9, line 45-col.10, line 13). However, Mallicoat does not teach the narrow-band eraser device.

Tang et al teaches the narrow-band eraser device (summary; figs.1a-1d, 2a-2b; col.4, lines 3-33).

Thus, it would have been obvious to the person of ordinary skill in the art at the time of invention to incorporate the teaching of Tang et al into Mallicoat to perform the narrow erasing functions.

Regarding Claims 17-19, Mallicoat teaches an eraser device further comprising a plurality of ultra-sound transmitters and a plurality of infra-red transmitters for identifying contact with the presentation board (figs.1-3,5,7; summary).



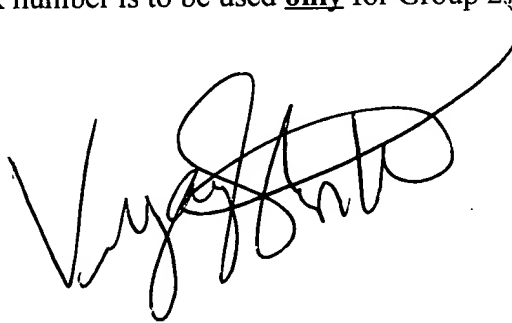
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18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Murakami et al, Miyamori et al, Enokido et al, Mallicoat all teach a presentation board digitizer system and the eraser device.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIJAY SHANKAR whose telephone number is (703)305-4763.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group's new FAX number is (703)308-9051. This FAX number is to be used only for Group 2700 papers.

A handwritten signature in black ink, appearing to read 'Vijay Shankar', with a large, sweeping flourish extending from the end of the name.

**VIJAY SHANKAR  
PRIMARY EXAMINER  
GROUP 2700**